

REMARKS

In the Office Action, claims 1-20 were rejected. Claim 16 stands rejected under 35 U.S.C. 112 as failing to comply with enablement requirement. Claims 1-20 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Claims 1, 2, 4, 6, 7, 9, 11, 14-16, 18 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer [U.S. Pat. 5,515,266]. Claims 3 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Horikiri et al [U.S. Pat. 5,765,154]. Claim 13 stands rejected under 35 U.S.C.103(a) as being unpatentable over Meyer in view of Horikiri and further in view of Steele et al [U.S. Pat 4,803,639]. Claims 5 and 17 stand rejected under 35 U.S.C.103(a) as being unpatentable over Meyer in view of Steele et al. Claims 8 and 20 stand rejected under 35 U.S.C.103(a) as being unpatentable over Meyer in view of Lawrence et al [U.S. Pat 5,033,010]. Claim 10 stands rejected under 35 U.S.C.103(a) as being unpatentable over Meyer in view of Hughes [U.S. Pat 6,523,502]. By the present Response, claims 1 and 9 and paragraph [0001] of the specification have been amended. Upon entry of the amendments, claims 1-20 will remain pending in the present patent application. Applicant respectfully requests reconsideration of the application in light of the above amendments and the following remarks.

Objections to the Specification

The Examiner objected to the disclosure due to the omission of "field of the invention" language and required appropriate correction to include the field of the invention. Accordingly, Applicant submits that paragraph [0001] has been amended to provide the field of the art to which the invention pertains.

Rejections Under 35 U.S.C. § 112

Claim 16 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner stated that the numeric descriptor recited in claim 16 is not supported in the specification.

The Court of Appeals for the Federal Circuit has repeatedly addressed the issue of sufficiency of disclosure, and that Court's precedent controls in these issues. Indeed, the standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) in terms of the degree of experimentation needed to practice the claimed invention, and whether this degree of experimentation is undue or unreasonable. The Federal Circuit continues to employ this same standard. *In re Wands*, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1998). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991). Moreover, it has long been settled that so long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claims, the enablement requirement under 35 U.S.C. § 112 is satisfied. *In re Fisher*, 166 U.S.P.Q. 18, 24 (CCPA 1970).

Although the Examiner may take exception to the terms used in the claims, he is reminded that the patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7th Cir. 1971), *aff'd*. 613 F.2d 775 (7th Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). The terms employed in the claims are clearly described in the specification, which provides adequate teaching for one skilled in the art to make and use the claimed invention.

In summary, the Examiner bears the burden of establishing a *prima facie* case of non-enablement. A specification disclosure which contains a teaching of the manner and process of making and using a claimed invention in terms which correspond to the scope

of those used in describing and defining the subject matter sought to be patented, as in the present case, must be taken as being in compliance with the enablement requirement. See Manual of Patent Examining Procedure, Section 2164.04. Withdrawal of the rejections under 35 U.S.C. § 112 is earnestly solicited.

Applicant respectfully submits that the specification supports the numeric descriptor as recited in claim 16. Support for claim 16 can be found in paragraph [0029] that describes use of a shorthand description referred as descriptive formats or descriptors. The specification provides details of the descriptor including that the descriptive format comprises a number with a decimal fraction. The number represents the engine unit number at the site and the decimal describes where in the unit the part is installed. The specification also provides an example of such a descriptor, along with the interpretation of such a descriptor in paragraph [0029]. Accordingly, Applicant requests that the Examiner reconsider and remove the §112 rejection of claim 16.

Rejections Under 35 U.S.C. § 101

Claims 1-20 were rejected under 35 U.S.C.101 as the claimed invention is directed to non statutory subject matter. The Examiner stated that independent claims 1 and 9 were specifically rejected as they are not drawn to computer executable code stored on computer readable medium. Claims 2-8 and 10-20 were rejected for being dependent from the rejected independent claims 1 and 9.

Applicant submits that claims 1 and 9 have been amended to recite the claims to be drawn to computer executable code on computer readable medium. Applicant therefore submits that the Examiner's rejection of claims 1 and 9 under 35. U. S. C. § 101 is successfully overcome.

In response to the rejection of the claims depending from claims 1 and 9, Applicant submits that since claims 1 and 9 have been suitably amended to overcome the Examiner's rejection, claims 2-8 and 10-20 also overcome the rejection.

Rejections Under 35 U.S.C. § 103

Claims 1, 2, 4, 6, 7, 9, 11, 14-16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer (hereafter Meyer) [U.S. Pat. 5,515,266]. Rejected claims 1 and 9 are independent and will be discussed in detail below.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

In the rejection of independent claims 1 and 9, the Examiner acknowledged that Meyer fails to disclose entering the part status at the end of an outage into a database. Meyer teaches a method of tracking part histories by acquisition of data that can be analyzed to improve planning in connection with maintenance work. However, Meyer repeatedly stresses that such data are brought up to date at least intermittently, preferably at least periodically, and most preferably *continuously or quasi continuously*. Meyer fails to disclose acquisition of data at the end of maintenance work.

Applicant points out that as recited in claim 1 and claim 9, the part data is recorded whenever a service outage occurs, and specifically the part status is entered at the end of the service outage to track the entire history of the parts. In addition, Applicant's invention prescribes performing such tasks based on service outages to minimize the stipulation of event dates, thereby simplifying compilations of site history to outage dates. Further, Applicant's invention is particularly advantageous as it includes tracking the data at the end of the service outage, and thus during each corresponding period to enable a complete part history. This complete part history is used for estimation of the remaining life of the parts. Applicant respectfully submits that there is no suggestion in Meyer that would have motivated an ordinarily skilled artisan to modify Meyer for the purpose of including the part data at the end of an outage.

Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established for the independent claims 1 and 9.

With regard to dependent claims 2, 4, 6, 7, 11, 14-16, 18 and 19, these claims depend directly or indirectly from allowable claims 1 and 9, and are therefore considered to be allowable.

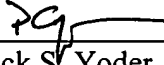
Claims 3 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Horikiri et al (hereafter Horikiri) [U.S. Pat. 5,765,154]. Claim 13 stands rejected under 35 U.S.C.103(a) as being unpatentable over Meyer in view of Horikiri and further in view of Steele et al (hereafter Steele) [U.S. Pat 4,803,639]. Claims 5 and 17 stand rejected under 35 U.S.C.103(a) as being unpatentable over Meyer in view of Steele et al. Claims 8 and 20 stand rejected under 35 U.S.C.103(a) as being unpatentable over Meyer in view of Lawrence et al (hereafter Lawrence) [U.S. Pat 5,033,010]. Claim 10 stands rejected under 35 U.S.C.103(a) as being unpatentable over Meyer in view of Hughes (hereafter Hughes) [U.S. Pat 6,523,502]. Because claims 3, 12, 13, 5,17, 8 and 20 depend allowable independent claims 1 and 9 these claims are patentably distinguishable over Meyer. Applicant respectfully submits that Horikiri, Steele, Lawrence and Hughes do nothing to obviate the deficiencies of Meyer, and that all dependent claims now pending are in condition for allowance.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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